



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/701,278	08/22/96	ANDERSON	A-63770-1/RF

HM21/0625
FLEHR HOHBACH TEST ALBRITTON & HERBERT
FOUR EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO CA 94111

EXAMINER
HAYES, R

ART UNIT	PAPER NUMBER
1645	13

DATE MAILED: 06/25/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

08/701278

Applicant(s)

Anderson

Examiner

Hayes

Group Art Unit

1645

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/27/98.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-2, 4-17 is/are pending in the application.
- Of the above claim(s) 8-17 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-2, 4-7 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-2, 4-17 ^{were} are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1645

DETAILED ACTION

Response to Amendment

1. The amendment filed 03/27/98 has been entered.
2. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1645.
3. The rejection of claims 1-2 & 5-7 under 35 U.S.C. 112, first paragraph, is withdrawn due to the amendment of the claims, and because Applicants' arguments on page 4 of the response are persuasive, when combined with the disclosure on page 20 of the specification, that nucleic acids encoding an encoded DRG11 protein of SEQ ID NO: 2 are enabled.
4. The rejection of claim 2 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn due to the amendment to the claim.
5. The rejections of claim 1 under 35 U.S.C. 102(b) as being anticipated by Liu et al., and by Cserjesi et al., are withdrawn due to the amendment of the claims to require "natural expression is absent in ... ventricular neurons of the spinal cord", and "absent in non-neuronal cells...", as argued by Applicants' on page 6-7 of the response.

Art Unit: 1645

6. Applicant's arguments filed 03/27/98 have been fully considered but they are not deemed to be persuasive.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-2 & 4-7 are again rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al., for the reasons made of record, and as follows.

Applicants argue on page 6 of the response that Saito et al. is not prior art, because "the one year date prior to this [priority] date [of 7/25/96], falls within weeks of [the submitted date] of June 14, 1995". However, the issue remains that the June 14, 1995 date of submitting this sequence to Genbank is "more" than one year before the priority date; thereby, constituting a proper 102(b) reference. Moreover, the publication reference of Saito et al. that was part of the previous rejection (IDS reference #1; Molec. Cell. Neurosci.) was published 6/1/95, and was also referenced in the Genbank submission; thereby, constituting a statutory bar against Applicants' invention, which was not filed until 7/25/96. It is further noted that Applicants provide no documentary evidence that Saito's DRG11 nucleic acid sequences, including SEQ ID NO:1, were not available to the public within a year of the priority claimed (i.e., not until 2/10/96, versus June 1995). In *arguendo*, assuming that the rejection is a 102(a) rejection, the previous Office action had already made of record that the four authors within Saito et al. are not the same

Art Unit: 1645

inventive entity of the instant invention, which has only two inventors. It is noted that Applicants have not addressed this part of the rejection.

Saito et al disclose a polynucleotide sequence that is 100% identical to SEQ ID NO 1 (i.e., Genbank Accession No. U29174, submitted June 14 1995; see also pg. 291 of Saito et al., 2nd *pp*; as it relates to claims 1 & 4). The amino acid sequence encoded by this nucleic acid molecule is disclosed in Figure 3 (pg. 283; as it relates to claim 2). In that the DRG11 cDNA clones (pg. 282, last *pp*) were cloned into the *E.coli* λ ZapII expression vector, and screened (i.e., *E.coli* host cells transformed with the DRG11 clones), and the clone encoded/produced a novel 28.6 kDa protein, the limitations of claims 5-7 are anticipated by Saito et al. (Molec. Cell. Neurosci.). In that the complimentary DNA sequence of these clones would inherently hybridize to SEQ ID NO 1, the limitations of claim 1 are also met.

It is again noted that this rejection is based *in part* upon a disclosure provided in a computer database record. Because the database was indexed so as to be available to the relevant part of the public, it is considered to be a U.S.C. § 102; see *In re Wyer*, 210 USPQ 790.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1645

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.
June 22, 1998



ANTHONY C. CAPUTA
PRIMARY EXAMINER